

### **Remarks**

Claims 1-16, 18-24, 29-33, and 35 are pending in this application. Claims 1-12 and 18-24 have been withdrawn from consideration. Claims 13-16, 29-33, and 35 have been rejected. Applicants respectfully request reconsideration of the rejected claims in light of the following remarks.

### **Rejection of claims 13-15, 31, and 35 as being unpatentable over Lindquist**

Claims 13-15, 31, and 35 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Lindquist et al. (U.S. Patent No. 3,665,918). Applicants respectfully traverse this rejection.

By previous amendment, Applicants added a limitation to claim 13, which recites that foam cells of the article are "ruptured or enlarged by stretching the formed article thereby permanently increasing the moisture vapor transition rate of the article." Lindquist does not teach or describe rupturing or enlarging by stretching foam cells of the article. The Examiner has identified nothing in Lindquist that expressly or inherently discloses this limitation. The Examiner has not even alleged that such a teaching is found in Lindquist. Instead, the Office Action simply states that "the Examiner takes Official Notice that rupturing or enlarging foam cells to increase its permeability is old and well known." (Office Action, p. 3.) In support of this conclusion, the Office Action cites Watson (U.S. Patent No. 3,862,282), which purportedly demonstrates a method for rupturing cellular membranes of polyurethane foams, as evidence of the state of the art. However, a claim is anticipated under § 102 "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 629 (Fed. Cir. 1987); MPEP 2131. Since the Examiner has had to rely on sources of prior art other than Lindquist in order to find a teaching of rupturing or enlarging foam cells, the Office Action has failed to establish that all of the elements of claim 13 are found in a single prior art reference. For this reason, claim 13 and those claims that depend from claim 13 cannot be rejected under § 102 as being anticipated by Lindquist.

In order to establish a *prima facie* case of obviousness, the Patent Office must demonstrate that (1) there is a suggestion or motivation in the prior art to modify or combine reference teachings, (2) one skilled in the art would have had a reasonable expectation of success in making

the modification or combination, and (3) the prior art reference(s) disclose all of the claim limitations. The fact that one of ordinary skill in the art would have had the capability to modify the method disclosed in the prior art reference(s) is not sufficient. MPEP 2143.01. The prior art reference(s) must provide a motivation or reason for making the changes. MPEP 2142; *Ex parte Chicago Rawhide Manufacturing Co.*, 226 USPQ 438 (PTO Bd. App. 1984).

As discussed above, Lindquist does not disclose all of the elements of claim 13. Thus, Lindquist alone cannot render claim 13 obvious. Although the Office Action asserts that Watson discloses rupturing cellular membranes of polyurethane foams, this reference is merely cited to show the general state of the art and is not expressly relied upon by the Examiner as a basis for rejection nor does the Examiner identify any motivation for combining the teachings of Watson with those of Lindquist. Even if, as the Examiner has asserted, rupturing or enlarging foam cells by stretching was generally known in the art as a means for increasing permeability, there must still be some motivation or suggestion, found in the prior art, to apply this technique to the Lindquist material. However, the Office Action provides no evidence that any such motivation is found in the cited references or elsewhere in the prior art. The Office Action merely states in conclusory fashion that "it would have been obvious to one of ordinary skill in the art to rupture the cellular membranes in Lindquist's foam, motivated by the desire to increase its permeability." This assertion, by itself, is not sufficient evidence to establish a motivation to stretch cells of the Lindquist foam, because the Office Action does not identify anything in the cited references that would have provided a desire to increase the permeability of Lindquist's articles much less a desire to do so by stretching them. See *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) (holding that obviousness cannot be established by modifying or combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.") Since there is nothing in the cited references that teaches or suggests the desirability of increasing the permeability of the Lindquist articles by rupturing or enlarging foam cells by stretching them, the claimed invention is not obvious over Lindquist.

Additionally, Applicants note that the Examiner has previously acknowledged that "Lindquist does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam." (Office Action mailed 11/06/02, p. 5) The Examiner nevertheless

contends that this modification would be obvious because it is believed that "the moisture vapor transition rate of the breathable foam of Lindquist inherently increases when stretched." *Id.* However, the doctrine of inherency is inapplicable in the context of an obviousness rejection under § 103. See *In re Shetty*, 566 F.2d 81, 86 (CCPA 1977). Even if the moisture vapor transition rate of the Lindquist foam would inherently increase upon stretching, the Patent Office has failed to demonstrate any motivation in the cited art to stretch the Lindquist foams. Without such a motivation there can be no *prima facie* case of obviousness in view of these references.

Applicants respectfully submit that the rejection of claims 13-15, 31, and 35 under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Lindquist has been overcome and should be withdrawn.

#### **Rejection of claims 13-16 as being unpatentable over Walther**

Claims 13-16 stand rejected under 35 USC § 103(a) as being unpatentable over Walther (U.S. Patent No. 5,905,097). Applicants respectfully traverse this rejection.

Walther fails to disclose rupturing or stretching foam cells. Although this element is missing from Walther, the Examiner asserts that claim 13 is nevertheless obvious over Walther because "rupturing or enlarging foam cells to increase its permeability is old and well known." (Office Action, p. 3). However, as discussed above, there must be some motivation or suggestion in the art to make the modification forwarded by the Examiner. Even if rupturing or enlarging foam cells was known as a means for increasing permeability, a *prima facie* case of obviousness does not exist unless the Patent Office can demonstrate that one of ordinary skill in the art would have been motivated to make this particular modification to the Walther foam. The Office Action offers no justification for why one skilled in the art would have been motivated to increase the permeability of the Walther foam by rupturing or enlarging the foam cells. Since Walther does not provide any motivation or suggestion for a thermoplastic material having foam cells that have been ruptured or enlarged by stretching the material thereby permanently increasing the moisture vapor transition rate of the article, this reference cannot support a case of *prima facie* obviousness against claim 13. Claims 14-16 each add additional features to claim 13, and thus are likewise patentable over Walther.

Applicants again point out that, as with Lindquist, the Examiner has previously acknowledged that "Walther does not specifically disclose that stretching can increase the moisture vapor transition rate of their breathable foam." (Office Action mailed 11/06/02, p. 9) The Examiner nevertheless contends that this modification would be obvious because it is believed that "the moisture vapor transition rate of the breathable foam of Walther inherently increases when stretched." *Id.* However, as discussed above, the inherency of a claimed element or advantage of the invention is irrelevant in the context of an obviousness rejection under § 103. See *In re Shetty*, 566 F.2d 81, 86 (CCPA 1977). Even if the moisture vapor transition rate of the Walther foam would inherently increase upon stretching, the Patent Office has failed to demonstrate any motivation in the cited art to stretch the Walther foams. Without such a motivation there can be no *prima facie* case of obviousness in view of these references.

Applicants respectfully submit that the rejection of claims 13-16 under 35 USC § 103(a) as being unpatentable over Walther has been overcome and should be withdrawn.

**Rejection of claims 29, 30, 32, and 33 as being unpatentable over Lindquist in view of Pufahl**

Claims 29, 30, 32, and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lindquist (U.S. Patent No. 3,665,918) in view of Pufahl (U.S. Patent No. 4,169,184). Applicants respectfully traverse this rejection.

Lindquist alone does not establish a *prima facie* case of obviousness, because, as discussed above, Lindquist does not teach or suggest rupturing or enlarging foam cells by stretching the article thereby permanently increasing the moisture vapor transition rate of the article. Pufahl does not cure this deficiency. Pufahl describes a foam substrate coated with a pressure sensitive acrylic resin adhesive. Pufahl teaches that a release tape may be applied to an outer surface of the adhesive layer. There is nothing in Pufahl that teaches or suggests or provides any motivation for rupturing or enlarging the foam cells by stretching. Since Pufahl does not disclose the claim elements that are lacking from Lindquist, these references even in combination do not render the claimed invention obvious.

With respect to claim 32, which the Examiner had previously indicated would be allowable if rewritten in independent form, the Office Action now states that the Examiner believes that a pressure sensitive tape or sheet comprising a multilayer backing which contains a foamed layer is

old and well known, and that applying an outer protective release layer on a pressure sensitive layer is conventional and common knowledge. Other than citing generally to Pufahl as showing an outer protective release layer, the Office Action fails to demonstrate that all of these features were in the prior art. Moreover, even if the Office Action did demonstrate that all of the claim elements are disclosed, the Office Action does not offer any evidence that one skilled in the art would have been motivated to make the combination of elements recited claim 32, even though such a showing is required to establish a *prima facie* case of obviousness. Applicants, therefore, submit that the Examiner's original view that claim 32 contains allowable subject matter was correct.

### Conclusion

In view of the foregoing remarks, it is submitted that the application is in condition for allowance. Applicants respectfully request reconsideration of the application and allowance of claims 13-16, 29-33, and 35.

Respectfully submitted,

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